

U.S. Pat. Appln. Serial No. 10/612,216
Response to Office Action dated October 18, 2004
Page 4 of 6

REMARKS

1. Double Patenting Rejection.

In the Office Action dated October 18, 2004 the Examiner rejected Claims 11 and 13-18 under 35 U.S.C. §101 as claiming the same invention as that of claims 1-7 of the parent application, now U.S. Pat. No. 6,616,653. Applicant filed the present application as a divisional of U.S. Pat. No. 6,616,653 on July 2, 2003. Concurrently with the filing of the divisional application, i.e. on July 2, 2003, Applicant filed a Preliminary Amendment canceling claims 11-20. A copy of the Preliminary Amendment and post card receipt is attached hereto as Exhibit A. Applicant believes the Preliminary Amendment obviates the double patenting rejection.

2. Rejection under 35 U.S.C. §102

The Examiner rejected claims 1, 3, 7-10 under 35 U.S.C. §102(b) as being anticipated by Costello et al. (U.S. Pat. No. 5,322,507). Specifically, the Examiner stated that Costello et al. disclose a non-implantable device for the treatment of prostate, the device comprising: a light source that provides a therapeutic light suitable for the required treatment (col. 1, lines 16-25); and a light source segment 68 that houses a laser light transmitting fiber 70, said light source segment being of sufficiently small size and configuration to be inserted through the urethra of a patient (col. 3, lines 53-56). In order to anticipate under §102, the reference must disclose each and every element of the claimed invention. In that regard, Costello does not disclose that the light source emits light which is absorbed by blood in blood vessels of the bladder as now claimed by amended claim 1. Because claims 2-9 depend from claim 1, it is respectfully suggested that claims 2-9 distinguish over Costello also.

Claims 11-14 and 17-20 were rejected under 35 U.S.C. §102(b) as being anticipated by Frank. Because these claims were canceled by Preliminary Amendment upon filing of the present application, it is believed this rejection is moot.

U.S. Pat. Appln. Serial No. 10/612,216
Response to Office Action dated October 18, 2004
Page 5 of 6

2. Rejection under 35 U.S.C. §103.

The Examiner rejected claims 2 and 4-6 under §103 as being unpatentable over Costello in view of Tulip (U.S. Pat. No. 5,059,200) and Ganz (U.S. Pat. No. 6,491,618) stating that Tulip teaches an alternative, non-implantable, laser lithotripter for treating urological disorders, the lithotripter comprising a pulsed light source having a pulse-width and wavelength as recited in the instant claims (col. 7, line 4-35). Applicant traverses the rejection.

Tulip teaches in the very passage cited by the Examiner that its laser lithotripter uses a laser light which is absorbed by water, not blood as claimed by Applicants. Because human stones (i.e. calcium oxalate body stones such as bladder and ureteral stones) are composed of water and calcium oxalate, when they absorb the laser light of Tulip, the stones disintegrate to powder and thus are capable of being washed away. Applicants, on the other hand, have invented a device that uses a light that is absorbed by blood in the vessels of the bladder to coagulate the blood in these superficial blood vessels, thus reducing detrusor hyperactivity. Tulip does not teach or suggest laser light that is absorbed by blood in the vessels of the bladder.

Alternatively, the Examiner cites col. 2, lines 9-15 and col. 10, lines 39-54 of Ganz. Ganz discloses at the cited passages an apparatus including a tungsten halogen lamp for emitting ultraviolet light to kill a particular strain of microbe. Ganz does not teach or suggest a light source that emits light that is absorbed by the blood in the vessels of the bladder.

Conclusion

Applicants have made a novel and non-obvious contribution to the art of treating urological disorders with its apparatus. Applicants respectfully submit that with the arguments and amendments presented herein all pending claims are allowable over the art of record, for at least the reasons discussed above, and respectfully requests that a Notice of Allowance be issued in this case.

If the Examiner believes that a teleconference would be of value in expediting the allowance of the pending claims, the undersigned can be reached at the telephone number listed below. This response has been filed within the three-month statutory time for response and it is,

U.S. Pat. Appln. Serial No. 10/612,216
Response to Office Action dated October 18, 2004
Page 6 of 6

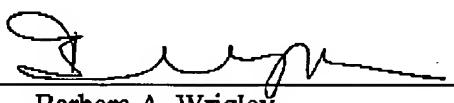
therefore, believed that no petition or payment for extension of fees is due. If, however, it is believed that any additional fees are necessary, the Commissioner is hereby authorized to charge or credit any such fees or overpayment to Deposit Account No. 50-1901 (Reference No. 687-411/US/3).

Dated: January 18, 2005

Respectfully submitted,

OPPENHEIMER, WOLFF & DONNELLY LLP
Attorneys for Applicant

By



Barbara A. Wrigley
Reg. No. 34,950
45 South 7th Street, Suite 3300
Minneapolis, MN 55402
Telephone No. (612) 607-7595
Facsimile No. (612) 607-7100
E-Mail Bwrigley@Oppenheimer.com

Customer No. 34205